

### **REMARKS**

Claims 1, 3-5, and 8-11 are pending. Applicants have made no claim amendments in response to this Office Action.

Applicants thank the Examiner for accepting the Drawings filed on December 1, 2000.

Applicants respectfully request reconsideration in view of the following remarks. Issues raised by the Examiner will be addressed below in the order they appear in the Office Action.

#### **Claim rejections under 35 U.S.C. § 112, first paragraph**

Claims 1, 3-5 and 8-11 are rejected under 35 U.S.C. § 112, first paragraph, because the specification, while being enabling for a transgenic mouse whose genome comprises a homozygous defect of a Caspase-9 gene, wherein said mouse lacks functional Caspase-9 and exhibits reduced apoptosis in brain, spinal cord, dexamethasone-treated lymphocytes, cardiac muscle, or smooth muscle, or reduced apoptosis associated with viral infection and a method of producing transgenic mouse whose genome comprises a homozygous defect of a Caspase-9 gene, allegedly does not reasonably provide enablement for mice where the genetic modification is not integrated into the genome. In particular, the specification allegedly does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Specifically, the Examiner states that “[t]he only enablement is when the defective caspase-9 gene occurs within the genome,” but argues that “the claims encompassing a genetically altered mouse where the defect is not integrated into the genome, but may occur as an extrachromosomal DNA molecule.” Applicants traverse.

The claims does not read on any embodiment where the defect is not integrated into the genome. The term “homozygous” limits the *caspase-9* gene to be an *endogenous* gene. As a skilled artisan will appreciate, if the *caspase-9* gene is on an extrachromosomal DNA molecule, such as a plasmid, it would not be appropriate to describe any mutation on such extrachromosomal DNA molecule as a “*homozygous*” mutation. Thus, independent Claims 1, 3, and 10 do not encompass

the allegedly non-enabled embodiment. Reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, first paragraph, are respectfully requested.

*Claim rejections under 35 U.S.C. § 112, second paragraph*

Claims 1, 3-5, and 8-11 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for allegedly failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Specifically, the Examiner argues that the claims are confusing “as they read on a mouse having a defective caspase-9 gene and another genetic alteration. There is no correlation between the genetic alteration and a defective caspase-9 gene.”

The Examiner does not elaborate, and Applicants do not understand what constitute “another genetic alteration,” or how the claims read on “another genetic alteration.” Clarification is respectfully requested.

However, if “another genetic alteration” refers to the embodiment that the Examiner described above, where there is a genetic alteration of a *caspase-9* gene on an extrachromosomal DNA molecule, Applicants traverse the rejection. As argued above, the pending claims do not encompass such an embodiment.

Thus, the instant claims are not indefinite. Reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, second paragraph, are respectfully requested.

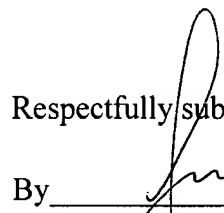
**CONCLUSION**

In view of the above arguments, Applicants believe the pending application is in condition for allowance.

Applicant believes no fee, other than the extension fee under 37 C.F.R. § 1.136(a) is due with this response. However, if any other fee is due, please charge our Deposit Account No. **18-1945**, from which the undersigned is authorized to draw under Order No. **VPI/98-104 CIP CON US**.

Dated: April 11, 2007

Respectfully submitted,



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